



Corres. and Mail  
**BOX AF**

AF/IFW

RESPONSE UNDER 37 C.F.R. § 1.116  
EXPEDITED PROCEDURE  
EXAMINING GROUP 2838

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

First Named  
Inventor : Kevin I. Bertness  
Appln. No.: 10/681,666  
Filed : October 8, 2003  
For : ELECTRONIC BATTERY TESTER  
WITH PROBE LIGHT  
Docket No.: C382.12-0169

Group Art Unit: 2838

Examiner: Edward H.  
Tso

Mail Stop AF  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

I HEREBY CERTIFY THAT THIS PAPER IS BEING  
SENT BY U.S. MAIL, FIRST CLASS, TO THE  
COMMISSIONER FOR PATENTS, P.O. BOX 1450,  
ALEXANDRIA, VA 22313-1450, THIS

6<sup>th</sup> DAY OF JUNE 2006  
A. Rego  
PATENT ATTORNEY

Sir:

This is in response to the Office Action dated March 7, 2006. In the Office Action, all pending claims 1-27 were rejected. Applicant respectfully requests reconsideration and allowance of all pending claims.

On Page 2 of the Office Action, claims 1-27 were rejected under 35 U.S.C. 103(a) as being unpatentable over Bertness (US 6,316,914) in view of Applicant's own admitted prior art.

The Federal Circuit has held that rejecting patents solely by finding prior art corollaries for the claimed elements would permit an Examiner to use a claimed invention itself as a blueprint for piecing together elements in the prior art to defeat the patentability of the claimed invention, which would be "an illogical and inappropriate process by which to determine patentability." *In re Rouffet*, 149 F.3d 1350, 1357 (Fed. Cir. 1998) (citing *Sensonics, Inc. v. Aerosonic Corp.*, 81 F.3d 1566,